



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/928,726      | 08/13/2001  | Denny Jaeger         | 4143/CIP-3          | 7153             |

7590

10/27/2003

Harris Zimmerman  
Law Offices of Harris Zimmerman  
Suite 710  
1330 Broadway  
Oakland, CA 94612-2506

|          |
|----------|
| EXAMINER |
|----------|

EISEN, ALEXANDER

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2674

DATE MAILED: 10/27/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/928,726

Applicant(s)

JAEGER, DENNY

Examiner

Alexander Eisen

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-17 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-11 and 22-29 is/are allowed.
- 6) ☒ Claim(s) 12 and 17 is/are rejected.
- 7) ☒ Claim(s) 13-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The allowance of claims 12-16 have been reconsidered and therefore indicated allowability of claims 12-16 is withdrawn. Rejections based on the new considerations follow.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claim 12** is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Liao, US 6,515,654 B1.

With respect to **claim 12** Liao discloses a touch screen system (FIG. 1) having at least one physical control device (sensing pen 20) operating on a touch screen (13) comprising a first antenna (333) secured adjacent to the touch screen (all electrical components are located on the control circuit board 30, which is adjacent to the touch screen 13), and control circuit means (transmitting circuit 33; FIGS. 3A-C) for driving said antenna to generate EM field extending across the touch screen;; the physical control device (pen 20) including resonant antenna means (FIG. 4) for receiving said EM field and re-radiating an electromagnetic response signal (column 3, lines 7-15); means for selectively operating said resonant antenna (switches 220, 230) when said physical control device is touched by a user (column 3, lines 36-38), and for selectively disabling said resonant antenna means when said physical control device is not touché by a user; said control circuit further including means for receiving said response (receiving circuit 34)

Art Unit: 2674

signal and entering a control command into an electronic device operatively associated with said touch screen system (column 3, lines 24-30).

Even though Liao does not explicitly call the pen a post assembly, the pen is definitely assembly, which can be broadly interpreted as a post.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Liao in view of Sakamoto et al., (“Sakamoto”), US 2001/0005198 A1.

Liao discloses a touch screen system comprising a first antenna secured adjacent to the touch screen; a sensing pen operating on a touch screen; control circuit means including transmitting circuit for driving said antenna to generate EM field extending across the touch screen; the pen including resonant antenna means for receiving and re-radiating an electromagnetic signal; means for receiving response signal, wherein the control circuit means includes means for generating a periodic signal for driving the first antenna.

Liao further teaches that the pen (20) has tip (FIG. 1) adapted to selectively (upon a user's action) provoke touch detection by the resistive touch screen (13), (column 2, lines 19-22); the resonant antenna (FIG. 4) includes an inductor (21) and a capacitor (22) secured within the pen (column 3, lines 16-18); and the means for selectively operating the resonant antenna

includes touch contact means (switch 220) on a barrel portion (FIG. 1) of the pen for completing a circuit between the inductor coil and the capacitor (FIG. 4).

Liao does not teach, however, that the button could have a cover to prevent an erroneous operation.

Sakamoto teaches a mouse having a click button (3) and a cover (2), which can be used for preventing an erroneous operation of the mouse (1) by inadvertently touching the button when not intended to use it (FIG. 1; paragraph [0033]).

It would have been obvious to one of ordinary skill in the art at the time when the invention was made to be motivated by the teachings of Sakamoto and provide a cover for the click button in the pen of Liao, because it could prevent the unintentional use of the button.

***Allowable Subject Matter***

6. **Claims 1-11 and 22-29** are allowed.
7. Claims **13-16** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. The following is a statement of reasons for the indication of allowable subject matter: none of the references, either individually or in combination, teach or fairly suggest, the touch screen system as claimed in claim 1 and the method as in claim 26 of the invention, wherein the physical control device comprises means for adhering the physical control device to the touch screen.

Art Unit: 2674

***Response to Arguments***

9. Applicant's arguments filed 18 July 2003 have been fully considered but they are not persuasive. Applicant argues that the invention and Sakamoto directed to two different input devices, a pen and a mouse, which are used in different modes and therefore the reference can be used for rejection. Examiner respectfully disagrees. Both the reference and the invention use a cover for protecting a switch, which is normally activated by user's finger, to prevent inadvertent or unintentional activations of the switch, and therefore both belong to analogous art.

The rejection is maintained.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Eisen whose telephone number is (703) 306-2988. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard A. Hjerpe can be reached on (703) 305-4709.

Any response to this action should be **mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

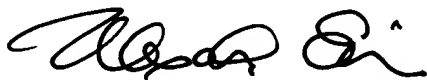
or **faxed to:**

**(703) 872-9314** (for Technology Center 2600 only).

Hand-delivered responses should be **brought to:** Crystal Park Two, 2121 Crystal Drive, Arlington, Virginia, Sixth Floor Receptionist.

Art Unit: 2674

Any inquiry of a general nature or relating to the status of this application or proceeding should be **directed to:** Technology Center 2600 Customer Service Office, whose telephone number is (703) 306-0377.

A handwritten signature in black ink, appearing to read 'Alexander Eisen', with a stylized flourish at the end.

Alexander Eisen  
October 21, 2003